

BL O/740/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3573681

BY

FISERV, INC.

TO REGISTER THE FOLLOWING TRADE MARK:

INSIGHTS360

AND

OPPOSITION NO. 60001713 THERETO

BY

360 FUND INSIGHT LIMITED

Background and pleadings

1. On 31 December 2020, Fiserv, Inc. (“the applicant”) applied to register the trade mark INSIGHTS360 in the UK, under number 3573681. The contested mark was accepted and published for opposition purposes in the Trade Marks Journal on 5 March 2021. Registration of the mark is sought in respect of the following services:

Class 36: *Financial data analysis for the financial sector; credit and debit processing data analysis for the financial sector; credit and debit portfolio analysis for the financial sector.*

Class 42: *Software-as-a-Service (SaaS) services to collect and analyze credit and debit processing data for the financial sector; Software-as-a-Service (SaaS) services to collect and analyze credit and debit portfolio data for the financial sector; Software-as-a-Service (SaaS) services to collect and analyze software use data for the financial sector.*

2. On 5 May 2021, 360 Fund Insight Limited (“the opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), on the basis of its earlier European Union Trade Mark (EUTM):



EUTM no. 017751439

Filing date: 31 January 2018

Registration date: 21 May 2018.

3. The entire list of services for which the mark is registered are relied upon in this opposition, i.e.:

35: *Advertising; Business management; Business administration; Office functions; Analysis of market research data; Business advice, inquiries or information; Market research by means of a computer data base;*

Business and market research; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Collecting information for business; Compilation and systemization of information into computer databases.

36: *Insurance; Financial affairs; Monetary affairs; Real estate affairs; Financial analysis; Financial advice; Financial investment consultancy and advisory services; Finance (provision of-); Providing of information online relating to financial investments.*

42: *Scientific and technological services, as well as related research and design services; Industrial analysis and research services; Design and development of computer hardware and software; Programming of software for financial consultancy and information platforms on the internet; Creation and development of data processing software; Providing search engines for obtaining data via communications networks; Providing of non-downloadable online software for managing online platforms and databases for financial consultancy.*

4. The opponent's mark is earlier in accordance with section 6 of the Act¹. However, as it had not been registered for five years or more before the filing date of the application, the opponent is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon any or all of the services for which the earlier mark is registered without having to establish genuine use.

5. In its notice of opposition, the opponent submitted that the respective services are identical or similar based on their nature, intended purpose, user and method of use.

6. The opponent also contended that the reproduction of its earlier trade mark into standard script is '360 FUND INSIGHT'. The opponent provided at Annex 1 of its notice of opposition an Extract From The Register Of European Union Trade Mark

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

Applications And Registrations to support this submission. The opponent further contended that although the term '360' is stylised, the characters '3', '6' and '0' are clearly depicted and consequently must be taken into account when assessing the similarity of the marks. With this in mind, the opponent argued that the marks are visually similar in so far as each mark contains the identical elements '360' and 'INSIGHT'.

7. The opponent contended that the figurative element within its mark would be pronounced as '360', which means there is a high degree of phonetic similarity between the two marks as they each contain the identical elements '360' and 'INSIGHT'.

8. As to the conceptual comparison, the opponent contended that the term 'FUND' in the earlier right is known in the provision of financial services by the relevant public, and is therefore non-distinctive, which subsequently leads to the dominant and distinctive elements of the mark being '360' and 'INSIGHT'. The opponent submitted that the words forming the application are entirely encapsulated within its earlier mark. The opponent argued that based on the fact that both marks contain '360' and 'INSIGHT' there is a high degree of conceptual similarity.

9. As a result of the aforesaid, the opponent claimed the relevant public will likely perceive the application as part of the same product family belonging to the opponent. The opponent contended that this results in a strong likelihood of confusion and also a likelihood of association on the part of the relevant public throughout the United Kingdom.

10. On 21 July 2021, the applicant filed a counterstatement denying the grounds of opposition.

11. Neither side filed evidence.

12. Only the applicant filed written submissions. The applicant submitted that the strong and dominant element of the earlier mark is the figurative element. This is because it is eye-catching, it is the height of the mark as a whole, and it incorporates colour. In addition, the applicant submitted that the figurative element sits at the beginning of the mark, being where the average consumer tends to focus, and will

therefore not be overlooked or misremembered by the consumer. The applicant argued that the figurative element in the earlier mark leads the overall impression created by the sign as a whole and has no counterpart in the current application. The applicant contended that the dominant figurative element of the earlier mark contributes significantly to there being a differing overall impression from the applicant's sign. The applicant submitted that the dominance of the figurative element is further enhanced by the fact that the words 'FUND' and 'INSIGHT' contained within the earlier mark are descriptive and laudatory, and therefore have a low level of distinctive character. The applicant disagreed that the figurative element of the opponent's mark is the number '360', as according to the applicant it is not possible to discern this fact from the image provided. The applicant argued that the single point of visual similarity between the two marks is the word 'INSIGHT'.

13. From an aural comparison standpoint, the applicant submitted that the figurative element will not be pronounced and therefore the earlier right only possesses the three syllables 'fund-in-sight', whereas the applicant's mark contains the eight syllables 'in-sights-three-hun-dred-and-six-ty'. The applicant went further to state that the elements 'INSIGHT' and 'INSIGHTS' are at opposite positions of the respective marks in terms of their verbalisation within each sign, with the element 'INSIGHT' appearing at the end of the opponent's mark whilst the element 'INSIGHTS' appears at the beginning of the applicant's mark. The applicant acknowledged that the signs are verbally similar to a certain degree, as they both contain the term 'INSIGHT', which it describes as descriptive and non-distinctive. However, the applicant submitted that this is as far as the similarities go.

14. The applicant submitted that no conceptual comparison can be made in relation to the figurative element of the earlier mark as it has no coherent meaning. However, the applicant stated that the remaining verbal elements were conceptually similar to a certain degree but only insofar as they share the descriptive and non-distinctive word 'INSIGHT'. The applicant submitted that because the common element in the marks is descriptive, greater weight will be attributed to the remaining element, which is the distinctive and dominant figurative element. The applicant further submitted that notwithstanding the principle of imperfect recollection, the figurative element of the earlier mark will be sufficient to enable the consumer to differentiate between the

marks, even for services which are identical, consequently meaning that there will be no likelihood of direct confusion.

15. The applicant made the additional submission that the services applied for are highly specialised and will be purchased by professionals in the financial sector. The applicant submitted that because the only common element [INSIGHT] is not strikingly distinctive, the consumer would have no reason to believe that only one undertaking would use it, nor would they assume an economic connection between the parties solely on this basis. The applicant argued that a finding of indirect confusion should not be made merely because the two marks share a common element, which in this case it is argued is descriptive, and further it is not sufficient that a mark merely calls to mind another mark. The applicant argued that this would be mere association, which is not indirect confusion.

16. No hearing was requested and so this decision is taken following a careful perusal of the papers.

17. Both parties are professionally represented. The applicant is represented by Barker Brettell LLP and the opponent is represented by BRYERS LLP.

Decision

Section 5(2)(b)

18. Section 5(2)(b) of the Act is as follows:

“(2) A trade mark shall not be registered if because-

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Section 5A

19. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion..

21. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Comparison of services

22. The applicant has acknowledged that some of the services at issue are identical, and has also identified that the services covered by both the opponent and themselves are highly specialised, and will be purchased by professionals operating in the financial sector who have a particular emphasis on the analysing and processing of financial data and information.

23. Whilst the applicant's comments are noted, the degree of similarity or identity as the case may be, is something which fundamentally contributes to whether there is a likelihood of confusion. I must therefore conduct a full analysis of the services at issue.

24. The parties' respective specifications are:

Earlier mark	Application
Class 35: Advertising; Business management; Business administration; Office functions; Analysis of market research data; Business advice, inquiries or information; Market research by means of a computer data base; Business and market research; Business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; Collecting information for business; Compilation and systemization of information into computer databases.	
Class 36: Insurance; Financial affairs; Monetary affairs; Real estate affairs; Financial analysis; Financial advice; Financial investment consultancy and advisory services; Finance (provision of-	Class 36: Financial data analysis for the financial sector; credit and debit processing data analysis for the financial

); Providing of information online relating to financial investments.	sector; credit and debit portfolio analysis for the financial sector.
Class 42: Scientific and technological services, as well as related research and design services; Industrial analysis and research services; Design and development of computer hardware and software; Programming of software for financial consultancy and information platforms on the internet; Creation and development of data processing software; Providing search engines for obtaining data via communications networks; Providing of non-downloadable online software for managing online platforms and databases for financial consultancy.	Class 42: Software-as-a-Service (SaaS) services to collect and analyze credit and debit processing data for the financial sector; Software-as-a-Service (SaaS) services to collect and analyze credit and debit portfolio data for the financial sector; Software-as-a-Service (SaaS) services to collect and analyze software use data for the financial sector.

25. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26. It has also been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

27. The nature of the contested services in Class 36 is that of analysis, specifically in relation to forms of finance and the financial sector, e.g. *financial data analysis*; *credit portfolio analysis*. The services in Class 36 of the earlier right include *financial affairs* and *financial analysis*. The contested services in Class 36 are identical to the services on which the opposition is based. This is due to the fact that services such as *financial data analysis* and *credit portfolio analysis*, for example, are included in the more

general category of the *financial analysis* of the designated earlier mark. This finding is in accordance with the principles established in *Meric*.

28. The contested services in Class 42 are all types of software-as-a-service, the purpose of which is to collect and analyze data for the financial sector, specifically in respect of *credit and debit processing data; credit and debit portfolio data and software use data*. The services in Class 42 of the earlier right include *creation and development of data processing software*. The *collection and analysis of data* is in effect highly similar, if not identical, to the processing of data. The services of the contested mark provide the actual collection and analysis of data via software, whereas the *creation and development of data processing software* service of the earlier right creates and develops the software that would carry out said data processing. The users and trade channels of the respective services are therefore likely to be the same, and as a result the contested services in Class 42 are similar to at least a medium degree with the Class 42 *creation and development of data processing software* services on which the opposition is based.

29. In the alternative, I find that these services are complementary. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

30. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

31. The provision of the contested mark’s *software-as-a-services to collect and analyze data* is not possible without the data processing software having first been created and developed, in much the same way as the *transport of chickens* is not possible without *chickens*. There is indeed, therefore, a close connection between the contested services and the services of the earlier right, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the services lies with the same undertaking, or at the very least that the consumer would expect an economic link between the two. Therefore, if the services at issue are not similar to at least a medium degree as I found in paragraph 28, then they are at least complementary.

32. The services in Class 42 of the earlier right also include *programming of software for financial consultancy and information platforms on the internet*. The *programming of software* is highly similar, if not identical, to the *creation and development of software*. Therefore, having found that the *creation and development of data processing software* service in Class 42 of the earlier right is similar to at least a medium degree with the contested *credit and debit processing data; credit and debit portfolio data and software use data* services in Class 42, then the same must apply to the *programming of software for financial consultancy and information platforms on the internet* service of the earlier right, especially as both sets of services have the same users and trade channels.

33. The services in Class 42 of the earlier right further include *providing of non-downloadable online software for managing online platforms and databases for financial consultancy*. The *provision of online software* in Class 42 is very similar to the provision of the contested *software-as-a-service* in Class 42, especially when considering that each party's services specialise in the financial sector, and that both sets of services have the same users and trade channels. As a result, the contested services in Class 42 are also similar to at least a medium degree with the *providing of non-downloadable online software for managing online platforms and databases for financial consultancy* services on which the opposition is based.


Comparison of marks

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

36. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	<p data-bbox="976 376 1185 409">INSIGHTS360</p>

37. The opponent’s mark contains a figurative element which, according to the opponent, is a representation of the number ‘360’. The opponent pointed out that when the earlier right was recorded in “standard script” on the relevant EU records, which it provided with the notice of opposition, the number ‘360’ was indeed presented in standard text. It must be borne in mind, however, that an evaluation of a figurative trade mark, which is the mark type the earlier sign is recorded as, is focused on the mark itself and how it appears. The consumer who perceives the sign will not be privy to the standard script as recorded on EU administrative documents, rather they will evaluate the way the trade mark appears as it has been registered.

38. The figurative element in the earlier mark consists of a combination of lines and circles, made up of the colours blue and green. Whilst the opponent has argued the figurative element is the number ‘360’, I do not consider that this will likely be perceived. It is possible that with focused attention a certain consumer may perceive the number ‘3’ as it acts as a border to the remaining part of the figurative element, and also because the colour contrast caused by the darker blue against the lighter green allows it to stand out. However, it does not follow that the numbers ‘6’ and ‘0’ making up ‘360’ will be perceived, as the colours are less bold and the size of the numerals, if perceived as such, shrink significantly. If there does exist a consumer who may perceive the additional numbers ‘6’ and ‘0’ as a result of their heightened level of attention reflecting the specialised nature of the services, I believe that such a consumer will be in the minority.

39. Although the figurative element of the earlier mark is on the left side of the trade mark reading from left to right, it is not an automatic consequence that it will strike the eye more in the overall impression. The sign comprises two elements: a figurative aspect and a verbal aspect. The words ‘FUND’ and ‘INSIGHT’, which are stacked one on top of the other, equate to roughly the same size as the figurative element, so

neither element can be considered to be more eye-catching or dominant. I consider the figurative element to be the more distinctive aspect, due to the fact that the terms 'FUND' and 'INSIGHT' are somewhat descriptive or lowly distinctive given the context of the services provided.

40. The contested mark consists entirely of the word 'INSIGHTS' and the number '360', conjoined and presented in standard typeface. Whilst use of letters and numbers creates a natural break between 'INSIGHTS' and '360', the average consumer will perceive the contested mark as a single unitary term, with neither the word nor number element being more distinctive or dominant than the other. The overall impression therefore lies in the perception of the combination 'INSIGHTS360' as a whole. There is no figurative counterpart in the applicant's mark.

Visual similarity

41. Visually, the respective marks are similar in that they share the letters 'I-N-S-I-G-H-T'. In each mark these letters are presented in a similar basic font. The contested mark contains an additional letter 'S' at the end of the term 'INSIGHT', which is not present in the earlier mark. The contested mark also contains the number '360', which is not equally represented in the earlier mark. The earlier mark contains the additional term 'FUND', which is not shared with the contested mark and which is placed on top of the word INSIGHT. In addition, the earlier mark contains a heavily stylized figurative element, which has no counterpart in the contested mark. The opponent has stated that this figurative element represents the number '360', however, due to the highly stylised nature of the figurative element, it is my opinion that this will unlikely be perceived by the average consumer. Whilst the marks share the letters that create the term 'INSIGHT' in a similar if not identical font, the marks each contain elements not present in the other sign, most notably the figurative element and the term 'FUND' in the earlier mark. These differences set the marks apart visually, leading me to find that the marks are visually similar to no more than a medium degree.

Aural similarity

42. Aurally, the opponent's earlier mark will be articulated as the two words 'FUND' and 'INSIGHT', with 'FUND' being spoken first due to its position above 'INSIGHT'. The

figurative element will not be articulated as it is unclear and cannot categorically be identified as the number 360, as claimed by the opponent. The applicant's mark will be articulated as the word 'INSIGHTS', and the number '360', with the number being articulated as either *three-hundred-and-sixty*, or *three-sixty*. In my opinion it is most likely that the element '360' will be verbalised by the average consumer as *three-sixty*, as it is common parlance to do so.

43. The marks share the two syllables *in-sight*. However, the marks differ as to their other verbal elements with neither 'FUND' nor '360' having a counterpart in the other side's mark. In addition, the respective marks are presented in such a way that the shared sound 'in-sight' will form the first sound in the contested mark and the final sound in the earlier mark. The marks are therefore found to be aurally similar to no more than a medium degree.

Conceptual similarity

44. The conceptual impact of the verbal elements of the opponent's earlier mark is that of insight in relation to a fund, i.e. providing accurate understanding² relating to a sum of money saved or made available for a particular purpose³. The opponent's earlier mark has an additional figurative element which has no immediately obvious concept, as it is a stylised figurative element. It is possible that a certain consumer may perceive the number '3' in the figurative element, which has an obvious meaning in isolation (that being the number), however this does not create a particular conceptual message when considered in combination with the other elements of the mark. Whilst I acknowledge that the number '3' may be perceived, although this is far from a certainty, I do not find it likely that a consumer will inspect the sign and perceive the number '360', as argued by the opponent. This is because it is heavily disguised within the body of the figurative element and is therefore indecipherable. In my opinion it would be a step too far to suggest that where a consumer does recognise the number '3' within the stylised element, that consumer would then go on to assume that the remaining lines and circles must therefore be the numbers '6' and '0'. As established

² <https://www.lexico.com/definition/insight>

³ <https://www.lexico.com/definition/fund>

in paragraph 38, if such an attentive consumer does exist, I consider them to be very much in the minority.

45. The applicant's mark conveys the concept of the number three hundred and sixty, or 'three-sixty', combined with the concept of the term 'INSIGHT'. My understanding of the number '360' is that it not only refers to degrees or a full circle, but that it is also understood in common parlance as meaning 'wholly encompassing', 'total' or 'complete'. I believe that this understanding of '360' will likely accord with the majority of the average consumer's understanding of the number. Unlike the opponent's earlier mark, which specifies a fund as being the subject of the insight, the applicant's mark does not divulge any information as to what the 'INSIGHT' relates. That having been said, due to the coupling of the concepts of 'INSIGHT' and '360', the overriding concept of the applicant's mark is that the insight offered will be wholly encompassing, total, complete, comprehensive etc. The marks are found to be conceptually similar to the extent that they both convey the notion of 'INSIGHT', however, this is the limit of the conceptual similarity. The marks are therefore found to be conceptually similar to only a low degree.

Average consumer and the purchasing act

46. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: Lloyd Schuhfabrik Meyer, Case C-342/97.

47. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

48. Considering the fact that the services at issue directly relate to the financial sector, the relevant consumer of those services will predominantly be a professional operating in the field of finance. The level of attention of a professional in this particular field is considered to be high. The services at issue are the type which could also provide key information to a person wishing to manage their own financial portfolio, with such a person not necessarily needing to be a professional. Nevertheless, it is likely that such an interested consumer will be au fait with the intricacies of the financial world and would therefore pay a higher level of attention than if they were buying everyday goods or services.

49. The selection of these services is not necessarily purely visual, as the purchase of services does not result in a tangible object that can be visually examined in the purchaser’s hand. That having been said, I do not dismiss the fact that the services will invariably be made available and purchased online using websites, which is very much a visual process. I also do not discount the possibility that the marks may be spoken over the telephone, for example, in a conversation between a consumer and a provider of such services, and therefore there may be an aural element to the purchase process.

50. Due to the financial nature of the services, it is considered that the level of attention paid by both a professional consumer and non-professional consumer will be high.

Distinctive character of the earlier trade mark

51. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

52. The opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character. The opponent did, however, concede that the term ‘FUND’ in the earlier right is known in the provision of financial services by the relevant public, and is therefore non-distinctive. The opponent has also claimed that the dominant and distinctive elements within its earlier mark are ‘360’ and ‘INSIGHT’. I have previously expressed my opinion of the figurative element in the opponent’s mark, specifically that I do not consider it likely to be perceived as the number ‘360’. The only element which is undisputedly present in each of the marks, therefore, is the term ‘INSIGHT’.

53. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said

in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

54. Although the opponent has identified the term ‘INSIGHT’ as being one of the dominant and distinctive elements of the earlier mark, I do not necessarily agree that the term ‘INSIGHT’ is in and of itself particularly distinctive in relation to services that relate to the analysis of data. The applicant referred to the term ‘INSIGHT’ as being descriptive, laudatory and not “strikingly distinctive”. It may be the case that there are more immediately and obviously descriptive terms in relation to the contested services, such as ‘Analysis’ or ‘Assessment’. However, the term ‘INSIGHT’, which means to provide accurate understanding⁴, certainly has a conceptual and semantical relationship to the process of analysing, which is a desirable attribute and a fundamental purpose of the contested services. The term is therefore considered to possess only a low degree of distinctive character. This consideration, coupled with the opponent’s admittance that ‘FUND’ is a known term in the financial sector, leads me to conclude that the figurative element is the most distinctive element of the earlier mark, and has no counterpart in the applicant’s sign. Considering the comments of Mr Iain Purvis QC at paragraph 39 of *Kurt Geiger*, the fact that the earlier right’s distinctive element has no counterpart in the applicant’s mark reduces the likelihood of confusion.

⁴ <https://www.lexico.com/definition/insight>

Likelihood of Confusion

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

56. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

57. I have found the marks to be visually similar to no more than a medium degree, aurally similar to no more than a medium degree, and conceptually similar to a low degree. I have identified the most distinctive element of the earlier mark to be the figurative element, which has no counterpart in the contested sign.

58. I have identified the average consumer to be a professional, or a non-professional with a specific interest in the financial sector, who will invariably select the services by visual means (although I do not discount the possibility that the marks may be selected over the telephone).

59. I have found the services in Class 36 to be identical, and the services in Class 42 to be similar to at least a medium degree. For some of the services in Class 42 I have found that if the degree of similarity is not at least a medium degree, then in the alternative they are complementary.

60. Despite the level of similarity between the services of the respective parties ranging from identical to at least a medium degree (or in the alternative complementary for some of the services), the differences in the visual, aural and conceptual comparison of the marks prevents a finding of direct confusion. This is because the differences between the marks far outweigh the solitary similarity of the term 'INSIGHT' appearing in both.

61. Although the level of attention paid by the average consumer will be high, the reality is that consumers rarely have the opportunity to make direct comparisons between trade marks. The services on offer do not appear side by side on a supermarket shelf, for example, and it is unlikely that a consumer will be faced with the marks at the same time. Rather, the marks will most likely be considered in isolation. The fact that only the earlier mark has a figurative element is, in my opinion, crucial in the comparison of the respective marks.

62. In *L&D SA v OHIM* [2008] E.T.M.R. 62, the CJEU stated that:

“55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant.”

In *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253 the GC compared two figurative marks, both of which contained the words “Museum of Illusions”. In holding that the words were weakly distinctive and that they were no more dominant than the figurative elements, it pointed out that:

“57 According to the case-law, the public will not generally consider a descriptive or weakly distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see judgment of 5 April 2006, *Madaus v OHIM – Optima Healthcare (ECHINAID)*, T-202/04, EU:T:2006:106, paragraph 54 and the case-law cited;

judgment of 28 October 2009, *CureVac v OHIM – Qiagen (RNAiFect)*, T-80/08, EU:T:2009:416, paragraph 49).

58 It does not therefore automatically follow that, where a sign consists of both figurative and word elements, it is the word element which must always be considered to be dominant. In certain cases, in a composite sign, the figurative element may therefore rank at least equally with the word element (see, to that effect, judgment of 24 October 2018, *Grupo Orenes v EUIPO – Akamon Entertainment Millenium (Bingo VIVA! Slots)*, T-63/17, not published, EU:T:2018:716, paragraph 43 and the case-law cited”).

63. In its notice of opposition, the opponent contended that the term ‘FUND’ in the earlier mark is known in the provision of financial services by the relevant public and is therefore non-distinctive. In the applicant’s submissions, it contended that the terms ‘FUND’ and ‘INSIGHT’ were descriptive and laudatory. The applicant went further in relation to the term ‘INSIGHT’, arguing that it was not “strikingly distinctive”. I agree with both party’s position that the term ‘FUND’ is non-distinctive and descriptive. I have also previously opined that the term ‘INSIGHT’ is considered to possess only a low degree of distinctive character. Bearing in mind the aforesaid, as well as the finding in *Metamorfoza* that the public will not generally consider descriptive or weakly distinctive elements of a composite mark to be the distinctive and dominant element, I consider the figurative element of the earlier mark to be the most memorable point of reference, especially when the consumer is relying on an imperfect recollection it has of the earlier mark in its mind.

64. As identified by Mr Purvis in *Kurt Geiger*, at paragraph 39:

“In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it”

65. Considering the fact that the most distinctive element of the earlier right, which is also at least co-dominant in that mark, has no counterpart in the contested trade mark, I do not consider it likely that there will be any direct confusion.

66. Having found that there is no direct confusion between the marks, I must now consider the possibility of indirect confusion.

67. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

68. These examples are not exhaustive, however, they do provide a helpful focus. For the purposes of clarity, I say again at this juncture that I do not agree with the opponent’s assertion that the figurative element of the earlier right will be perceived as the number ‘360’, even by a consumer paying a high degree of attention, as the stylisation involved is quite complex and intricate. Therefore, in relation to the marks at issue, the only commonality is the word ‘INSIGHT’, which has been found to have a low degree of distinctive character. Using Mr Purvis’ categories to assess the respective elements, I find that the common element ‘INSIGHT’ is not strikingly distinctive; the figurative element of the earlier mark cannot be said to be non-distinctive, rather I have found it to be the most distinctive element of the earlier mark and at least co-dominant; and the lack of that distinctive and dominant figurative element in the contested sign cannot be said to be logical or consistent with an obvious brand extension or evolution.

69. Considering the fact that the only common element in the marks at issue is the term ‘INSIGHT’, which has only a low degree of distinctive character, I find that the average consumer will not expect the provider of the services under the earlier mark to be the same, or even economically linked with the provider of the services under contested sign. I do not, therefore, find indirect confusion.

70. For the purposes of completeness, and having acknowledged in paragraph 38 that there may be a minority of relevant consumers who might perceive the number ‘360’ in the earlier mark, I will consider their position also. It is my opinion that if such a consumer’s perception is so acute as to perceive ‘360’ in the earlier mark, then this consumer would also perceive the more numerous aural, visual and conceptual differences between the marks. In addition, such a highly attentive and perceptive minority consumer cannot be considered to be the average or “typical”⁵ consumer, and therefore cannot dominate a true reflection of the “average consumer’s” attention.

⁵ Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), paragraph 60.

Further, and as was found in the judgment of the CJEU C-261/04 P, *Claude Ruiz-Picasso*, a higher level of attention may actually reduce the risk of confusion:

40 “Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between the marks relating to such goods at the crucial moment when the choice between those goods and marks is made”.

71. In the few instances where a minority of the average consumer of the relevant services does perceive the number ‘360’ within the earlier mark, they will also appreciate the fact that it is highly stylised and belonging to a different entity than the proprietor of the contested sign.

72. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

73. The fact that the contested and earlier marks share the common element ‘INSIGHT’ does not lead to indirect confusion. At best, it may lead to mere association, although in my opinion this is unlikely due to the dominance of additional elements within the earlier mark that have no counterpart in the contested mark.

Conclusion

The opposition fails. Subject to appeal, the application may proceed to registration in respect of all of the applied for services.

COSTS

74. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice

2/2015. In the circumstances I award the applicant the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a counterstatement and considering the

statement of the other side £200

Preparing written submissions in lieu £200

Total £400

75. I therefore order 360 Fund Insight Limited to pay Fiserv, Inc. the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of October 2021

Dafydd Collins

For the Registrar